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09/882,148	06/15/2001	Robert L. Barrett	END920010071US1	7985

7590  
IBM Corporation  
N50/040-4  
1701 North Street  
Endicott, NY 13760

EXAMINER
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JEANTY, ROMAIN

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* ROBERT L. BARRETT,  
9 ANNA M. GRANO,  
10 and LAWRENCE R. MAIER  
11

12  
13 Appeal 2009-000707  
14 Application 09/882,148  
15 Technology Center 3600  
16

17  
18 Decided: December 4, 2009  
19

20  
21 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.  
22 MOHANTY, *Administrative Patent Judges*.  
23 FETTING, *Administrative Patent Judge*.

24 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Robert L. Barrett, Anna M. Grano, and Lawrence R. Maier (Appellants)  
3 seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-13,  
4 the only claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
6 (2002).

7 SUMMARY OF DECISION<sup>1</sup>

8 We AFFIRM.

9 THE INVENTION

10 The Appellants invented a way of delivering integrated system solutions  
11 (Specification 1:3-4).

12 An understanding of the invention can be derived from a reading of  
13 exemplary claim 1, which is reproduced below [bracketed matter and some  
14 paragraphing added].

- 15 1. A method of business engagement, comprising the steps of:  
16 [1] defining an engagement model  
17 which will be used to address a marketplace requirement;  
18 [2] thereafter using said engagement model

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed July 24, 2007) and the Examiner's Answer ("Answer," mailed December 26, 2007).



1 engagement model to create an industry- wide engagement template  
2 applicable to all businesses in a marketplace was predictable.

3                                   FACTS PERTINENT TO THE ISSUES

4           The following enumerated Findings of Fact (FF) are believed to be  
5 supported by a preponderance of the evidence.

6           *Facts Related to the Prior Art*

7           *Young*

8           01. Young is directed to a business method focused on profitable  
9 customer relationships, based on a combination of the CRM, BI  
10 and CVM competencies, and includes (a) construction of an  
11 engagement model, followed by (b) phases, (c) activities, (d)  
12 tasks, (e) generation of work products, and (f) generation of  
13 technique papers. Young 1:62 – 2:2.

14          02. Young includes: repeatable engagement models; engagement  
15 templates containing instances of best practices and benchmarking  
16 data; focused activities that leverage business intelligence, CRM  
17 and CVM competencies that produce a customer management  
18 result for profitable, loyal relationships; a work breakdown  
19 structure that decomposes a series of complex tasks to support the  
20 customer-centric approach and its use of CVM techniques and  
21 best practices; and the use of examples, *templates* and technique  
22 papers. Young 2:59 – 3:5.

23          03. Among Young's tools are: an automated environment for  
24 downloading engagement models and their associated engagement

1 templates to the engagement teams (at the end of each  
2 engagement, this environment will also be able to upload the  
3 engagement team's work for intellectual capital harvesting and  
4 hardening purposes); automated tools used by the data framework  
5 to test hypotheses; and visual tools for automating the mapping  
6 and comparing of a client's existing and desired capabilities, with  
7 reference to "best practices". Young 3:6-20.

8 04. Young uses benchmarking data and industry best practices to  
9 provide industry-specific criteria for measuring performance and  
10 is based upon repeatable and reusable engagement models.  
11 Young 3:28-33.

12 *Barnes*

13 05. Barnes is directed to the professional service of delivering  
14 integrated system solutions. Barnes 1:7-8.

15 06. Barnes defines market initiatives and offerings using models  
16 and template components which are responsive and flexible to an  
17 ever-changing marketplace. Barnes 1:50-53.

18 07. Barnes provides an engagement family that includes an  
19 engagement model definition. Barnes 3:48-51. This model is used  
20 to address a marketplace requirement; and this engagement model  
21 is used to create an engagement template which specifically  
22 addresses client requirements within the marketplace. Client  
23 engagements are then measured, monitored and controlled based  
24 upon the engagement model. Barnes 2:17-24.

*Facts Related To The Level Of Skill In The Art*

08. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, professional services engagement management, or document processing. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

*Facts Related To Secondary Considerations*

09. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[ (1) ] the scope and content of the prior art are to be determined; [ (2) ] differences between the prior art and

1 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill  
2 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550  
3 U.S. at 406. “The combination of familiar elements according to known  
4 methods is likely to be obvious when it does no more than yield predictable  
5 results.” *KSR*, 550 U.S. at 416.

## 6 ANALYSIS

7 The Appellants argue the art fails to describe using an engagement  
8 model to create an industry- wide engagement template applicable to all  
9 businesses. The remaining limitations of defining an engagement model;  
10 using that engagement model to create an engagement template; modifying  
11 the engagement template to address requirements of a specific client; and  
12 thereafter measuring, monitoring, and controlling a client engagement based  
13 upon the engagement template are not in dispute.

14 This is hardly surprising since the whole purpose of an engagement letter  
15 is to address requirements of a specific client and thereafter measure,  
16 monitor, and control the client engagement based upon the engagement  
17 letter. This purpose and use of an engagement letter is not in dispute.  
18 Further, Young and Barnes describe this use of an engagement letter. FF 01-  
19 04, and 07. The use of a template per se is not in dispute. Barnes explicitly  
20 recites the use of a template for engagement letters. FF 05-07.

21 Thus the sole issue before us is whether it was predictable to use an  
22 industry-wide engagement template applicable to all businesses in said  
23 marketplace. The Examiner took Official Notice of the prevalence of this  
24 practice with templates in general, *i.e.* the modification of templates  
25 according to the marketplace. Answer 4. The Examiner found that Barnes



1 explicitly recited creating a model, *i.e.* a template, that addresses generic  
2 marketplace requirements and using that model to create an engagement  
3 template that specifically addresses client requirements within a specific  
4 marketplace. Answer 6. The Examiner also found that Appellants have  
5 argued limitations described in the Specification that were not in the claims,  
6 responding that limitations from the Specification are not imported into the  
7 claims. *Id.*

8 We agree with the Examiner that the whole point of a template is to  
9 modify it as it is applied to a particular purpose. We also agree that Barnes  
10 describes a marketplace wide engagement model that is derived from an  
11 engagement family applicable across markets. FF 07. Thus, Barnes' family  
12 corresponds to the claim model; Barnes' model corresponds to the claim  
13 template; and Barnes' template and project are a two tier example of the  
14 claim engagement. This market wide model or template in Barnes suggests  
15 the use of an industry-wide engagement template applicable to all businesses  
16 in a marketplace.

17 We further find that the limitation in claim 1 of an industry-wide  
18 engagement template applicable to all businesses in a marketplace does not  
19 narrow the contents of such a template, but only specifies the use to which  
20 such a template might be made. At most it might require the absence of  
21 content as to a specific industry, although since the template is to be  
22 modified, any such content could be deleted. But keeping a format lean in a  
23 template to accommodate changes is hardly new or unknown. Certainly the  
24 ultimate, albeit minimalist lean template, an 8 ½ x 11 blank sheet of paper, is  
25 an industry wide template that can be used for all businesses. But more  
26 pointedly, Barnes' model or template that exists prior to its use to create a

1 more narrowly tailored template implies an absence of a specific industry in  
2 its content prior to such narrowing. Thus we find the Appellants' arguments  
3 unpersuasive.

4 CONCLUSIONS OF LAW

5 The Appellants have not sustained their burden of showing that the  
6 Examiner erred in rejecting claims 1-13 under 35 U.S.C. § 103(a) as  
7 unpatentable over Young and Barnes.

8 DECISION

9 To summarize, our decision is as follows.

- 10 • The rejection of claims 1-13 under 35 U.S.C. § 103(a) as unpatentable  
11 over Young and Barnes is sustained.

12 No time period for taking any subsequent action in connection with this  
13 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

14  
15 AFFIRMED

16  
17  
18  
19 mev

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